mental capacity and if he does well at school there is nothing to stop him from earning a living in a sedentary occupation or even from achieving eminence in the professions or politics. Nevertheless I take into account the probability that he might not have the mental equipment necessary for these positions, in which event his lack of mobility would be a serious handicap to his future livelihood. Considering all these factors and considering the social class to which the plaintiff belongs (his father is a watchman who sends two of his sons to an English school) and giving this matter the best consideration I can in the circumstances, I award $7,500 general damages, that is, half the damages I would have awarded for 100% liability.

Mr. Murphy for the plaintiff cited cases from England to persuade me to award thirty to forty thousand dollars. I am of the opinion, however, that awards made by English courts should not be slavishly followed in Malaya. As Thomson C.J. said in *Pahang Lin Siong Motor Co. Ltd. and Bishen Singh* v. *Cheong Swee Khai and Loh Soo Chai*,[6]:

". . . . . local social, economic and industrial conditions are poles apart from conditions in England and Scotland and any tendency to take a particular line in relation to assessment of damages in cases of this type from a consideration of English and Scottish cases is not calculated to produce very useful results. Times may be changing but this is still not an industrial country. The economy is still, generally speaking, a peasant economy in which the typical figures are the small cultivator and the small trader. This in its turn, although of course strictly speaking it does not affect the value of money, produces the consequence that small sums of capital are more difficult to acquire and more sought after than in England and, when acquired, are much more prized and are of much greater economic utility. In England the ordinary working man would not, generally speaking, be greatly attracted by the prospect of enough capital to acquire a small agricultural holding or open a small shop whereas in this country such an opportunity would generally be welcomed with avidity. For example $25,000 in this country will purchase enough rubber land or padi land to enable a family to live in very great comfort with very little exertion. It is only in the most exceptional circumstances that a sum of £3,000 would produce such a result in England or Scotland.

Again, it must be remembered that, generally speaking, money wages are lower in this country than in England".

As regards costs, the plaintiff should get half his taxed costs.

Order accordingly.

Solicitors: *Murphy & Dunbar; Bannon & Bailey.*

TEH TEIK BOAY v. CHUAH SIAK LOO

[O.C.J. (Hepworth J.) December 12, 1961]

[Penang — Civil Suit No. 250 of 1961]

Patents and Designs — United Kingdom Designs (Protection) Ordinance, 1949, ss.2 and 4 — Designs registered under U.K. Registered Designs Act, 1949, ss.1 and 11 — Purported infringement — Injunction to restrain — Whether design new or original — Publication.

The plaintiff the registered owner of a design in respect of wooden stools claimed under the United Kingdom Designs (Protection) Ordinance, 1949, for an injunction to restrain the defendant from infringing his design registered under the Registered Designs Act, 1949, of the United Kingdom and an order for defendants to deliver up all infringing materials manufactured in the course of infringement of the said design, an account of all stools to which the said design had been applied made or sold or exposed for sale by the defendant; and profit made thereby; and damages and costs. The defence was that there was no infringement of the design because the design was not new or original and that stools of such design or of a design not substantially different had been manufactured for several years by the defendant and other furniture makers in the Federation of Malaya prior to the registration of the said design by the plaintiff. The defendant counterclaimed under section 4 of the Ordinance that exclusive privileges and rights in the said design had not been acquired in the Federation of Malaya by the plaintiff.

Held: there was publication of the design prior to the date of registration because stools substantially similar to those which had been manufactured to the design which was registered had been made by the defendant and sold to the public, presumably at a profit, in considerable quantities either directly or through furniture dealers over a period of five years prior to the registration of the design, and consequently the design was not new or original.

CIVIL SUIT.

Eusoffe Abdoolcader for the plaintiff.

C. O. Lim for the defendant.

Cur. Adv. Vult.

Hepworth J.: The plaintiff's claim is under the United Kingdom Designs (Protection) Ordinance, 1949, (hereinafter referred to as "The Ordinance") for an injunction to restrain the defendant from infringing the plaintiff's Registered Design No. 896082, registered under the Registered Designs Act, 1949, of the United Kingdom (hereinafter referred to as "The Act"), delivery up of all infringing materials manufactured in infringement of the said design, an account of all stools, to which such design has been applied, made or sold or exposed for sale by the defendant and profit made thereby, damages and costs.

The plaintiff is the registered owner of the Registered Design No. 896082 in respect of a wooden stool. The plaintiff claims that the defendant has infringed the said design in that subsequent to the registration of the said design the defendant has made and sold or offered for sale wooden stools manufactured in accordance with a design identical or similar to or not substantially different from the design disclosed in the complete specifications of the said Registered Design. Put briefly, the defence is that there has been no infringement of the design for the reason that the design was not new or original and that the design is a common design and stools of such a design or of a design not substantially different have been manufactured for several years by the defendant and other furniture makers in the Federation of Malaya prior to the registration of the said design by the plaintiff. The defendant also counterclaims for a declaration under section 4 of the Ordinance that exclusive privileges and rights in the said design have not

been acquired in the Federation of Malaya by the plaintiff upon the ground that at the date of its registration in the United Kingdom the said design was not new or original and that in fact it was a common one.

It was conceded by counsel for the plaintiff that the defendant's counterclaim is in order procedurally, because Order LIIIF Rule 3 of the English Rules, which is not duplicated in our Rules, is nonetheless applicable by virtue of Order 72 Rule 2 of our Rules. Rule 3 provides that a defendant in an action for infringement of the copyright in a registered design may, in regard to any registered design in issue, counterclaim for the rectification of the register of designs by the cancellation of the registration of the design.

I think that it is only necessary for me to refer to those facts in respect of which there has been substantially no contest. Evidence was led for the plaintiff to show that he had been manufacturing stools since 1949 of the design which has been registered and which appears clearly at page 11 of the agreed bundle "A". Steps to register the design of the stool were not, however, taken until 1959, the registration of the design was not effective until the 15th January, 1960, and notification of such registration was not received by the plaintiff until August, 1960. The design was advertised in the Federation of Malaya on the 24th August, 1960, and a Notice in writing to the defendant was sent on the 29th August, 1960 (page 24 of bundle "A"). On the 20th September, 1960, an agent of the plaintiff purchased six stools from the defendant, which stools had been manufactured by the defendant and were in all material particulars substantially similar to those manufactured by the plaintiff in accordance with the design which had been registered.

Evidence was led on behalf of the defendant to show that he had been manufacturing stools in a small way since 1949 and in a much bigger way since the end of 1954. It is clear that the defendant had, since the end of 1954 at least, been manufacturing stools substantially similar to those manufactured by the plaintiff and evidence was given on behalf of the defendant by four furniture dealers to the effect that they had since 1955 been buying many such stools made by the defendant and selling them to the public.

I find as a fact therefore that the plaintiff has been manufacturing stools since 1949 of a design similar to that which has now been registered, and that the defendant has, since the end of 1954 at least, been manufacturing stools of a design substantially similar to that which has now been registered. And I find as a further fact that such stools manufactured by the defendant have been sold in considerable quantities to members of the public since the end of 1954.

In passing I note that the furniture dealers referred to above all know the plaintiff and have bought stools from the plaintiff in the past as well as from the defendant. In other words both the plaintiff and the defendant were known in the furniture trade in Penang as makers of stools, and I think there can be little doubt that for some years past they were known to each other as makers of stools. I am reinforced in this view by the speed with which, after receipt by the plaintiff of notification of the registration of the design in August, 1960, and its advertisement in the press, the Notice in writing was sent to the defendant, which suggests that the plaintiff had been aware for some time before that the defendant was manufacturing such stools.

Mr. C. O. Lim on behalf of the defendant gave a closely reasoned argument as to why the design was not new or original, but I do not think it is necessary for me to set out this argument and answer the difficult questions posed by it because in my view there is a simpler and more compelling reason why the plaintiff's claim must necessarily fail. This reason is founded on the facts which I have already found.

Section 2 of the Ordinance reads as follows:—

"2. Subject to the provisions of this Ordinance, the registered proprietor of any design registered in the United Kingdom under the Patents and Designs Acts, 1907 to 1938, or any Act amending or substituted for those Acts, or any person deriving his right from such registered proprietor by assignment, transmission, or other operation of law, shall enjoy in the Federation the like privileges and rights as though the Certificate of Registration in the United Kingdom had been issued with an extension to the Federation".

Subsections (1) and (2) of section 11 of the Act read as follows:—

"11. (1) The registrar may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.

(2) At any time after a design has been registered any person interested may apply to the registrar for the cancellation of the registration of the design on the ground that the design was not, at the date of the registration thereof, new or original, or on any other ground on which the registrar could have refused to register the design; and the registrar may make such order on the application as he thinks fit".

Subsections (2) and (3) of section 1 of the Act read:—

"(2) Subject to the provisions of this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

(3) In this Act the expression 'design' means features of shape, configuration, pattern or ornament or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method of principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform".

Section 4 of the Ordinance reads as follows:—

"4. The High Court shall have power, upon the application of any person who alleges that his interests have been prejudicially affected, to declare that exclusive privileges and rights in a design have not been acquired in the Federation under the provisions of this Ordinance upon any of the grounds upon which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom".

It will be seen therefore that by virtue of section 4 of the Ordinance the High Court has power, upon the application of any person who alleges that his interests have been prejudicially affected, to declare that exclusive privileges and rights in a design have not been acquired in the Federation under the provisions of the Ordinance upon any of the grounds upon which the United Kingdom registration might be cancelled under the Act. It will be seen from subsection (2) of section 11 that the registrar may cancel the registration on the ground, *inter alia*, that the design was not, at the date of the registration thereof, new or original. From the wording of subsection (2) of section 1 I think it is clear that if an article is the same as a design which before the date of the application for registration has been registered or published in the United Kingdom it is not a design which is new or original. The question therefore is whether or not the design of a stool made by the plaintiff is an article which is the same as a design which was published (there is no question here of prior registration) before the date of the application for registration.

Broadly speaking, there is publication if the design has been disclosed to the public as opposed to being kept secret. The question which has to be decided is, therefore, has the public been put in possession of the design? Has it knowledge of the design? It is not necessary that the design should have been actually used. There will just as much be publication if it is shown that it was known to the public, without ever having been actually put in use. Thus publication may be of two types, (a) publication in prior documents, (b) publication by prior user. (See *Russell-Clarke's* Copyright in Industrial Designs, 3rd edition, page 39).

There will be publication if articles to which the design is applied are manufactured and used in such a way that members of the public may see them. It is not necessary that the prior user should have been sold, although, if there is anything in the nature of profitable user by the owner of the design prior to registration, there will undoubtedly be publication. (See page 45 of *Russell-Clarke, supra*).

As I have already said above, evidence which was not contradicted, and in fact not substantially contested by the plaintiff at all, was led to show that stools substantially similar to those which were manufactured to the design which has been registered had been made by the defendant and sold to the public, presumably at a profit, in considerable quantities, either directly or through the furniture dealers over a period of 5 years prior to the registration of the design. It seems to me that this constitutes publication of the design prior to the date of registration. In these circumstances it is in my view a design which is not new or original. It is pleaded in paragraph 4 of the defence that the design was not new or original. Paragraph 4 of the defence is repeated in paragraph 10 of the Counterclaim. That being the case the defendant is entitled to the declaration for which he is asking in his Counterclaim, and the plaintiff's claim must fail.

The plaintiff's claim is therefore dismissed with costs, and there will be judgment for the defendant on the counterclaim as prayed with costs.

Claim dismissed.

Solicitors: *Presgrave & Matthews; Lim, Lim & Oon.*

TRENGGANU LAND DEVELOPMENT BOARD. KUALA TRENGGANU v. TALIB

[C.A. (Thomson C.J., Syed Sheh Barakbah and Azmi JJ.) December 12, 1961]

[Kuala Trengganu — F.M. Civil Appeal No. 18 of 1961]

Contract — Special provisions as to settlement of dispute by arbitrator — Whether appointment of arbitrator proper — Trengganu Land Development Board — Whether board validly existed though appointment expired on 27.11.60.

Practice and Procedure — Whether service of Originating Summons was good under O.9 r.8(2).

On April 7, 1960 the appellant Board entered into a contract with the respondent for the clearing of 1,400 acres of land. The contract was in the English language and clause 40 provided that in the event of any dispute or difference between the parties such dispute or difference would, subject to certain conditions be "referred to the arbitration and final decision of a person nominated and appointed by agreement between the Chairman (of the Board) and the Contractor." The respondent proceeded to carry out a certain amount of work but ultimately disputes arose as to the extent of work and amount of payment. Preliminary steps, as provided in the agreement, were taken and letters in Malay were exchanged between the parties before the arbitrator entered upon his reference and made his award in favour of the defendant for a sum of $162,398.30 for work done under the contract. As payment of the said sum was not forthcoming the respondent issued an Originating Summons against the Board asking for leave to enforce the award as a judgment of the Court. Hepworth J. made an order as prayed. The Board now appealed. It was argued for the appellant that the appointments of all persons appointed to constitute the Board in 1959 expired on November 27, 1960 and that no order had yet been made appointing another Chairman and other members to constitute the Board and in consequence there was no validly appointed Chairman who could appoint an arbitrator. It was also argued that the trial Judge erred in law in holding that the service of the Originating Summons was good under the provisions of O.9 r.8(2) of the Rules of the Supreme Court and that there was a valid appointment of an arbitrator who could make a valid award against the respondent.

Held: (1) despite the fact that no appointments were made to the Board, it continued to exist after November 27, 1960 and therefore an appointment of arbitrator made by the Board's Chairman was a valid appointment;